<u>REMARKS</u>

Claims 1-4, 8-13 are amended. Claim 15 is added, and claims 7 and 14 are canceled. Thus, claims 1-6, 8-13 and 15 are now pending in the application. The amendments to the claims as indicated herein do not add any new matter to this application. Each issue raised in the Office Action mailed March 11, 2007 is addressed below.

I.   ISSUES NOT RELATING TO PRIOR ART

        <u>CLAIMS 4-6 AND 11-13 --- 35 U.S.C. § 101</u>

        The Office action at page 2 rejected claims 4-6 and 11-13 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In response to the rejection of claims 4-6, Applicants incorporate the statutory subject matter of dependent claim 7 into current claim 4. In response to the rejection of claims 11-13, Applicants incorporate the statutory subject matter of dependent claim 14 into current claim 11.

        Applicants submit that all current claims recite a practical application having a useful, concrete and tangible result, and are thus directed to statutory subject matter. Applicants respectfully request reconsideration and withdrawal of the rejections.

II.   ISSUES RELATING TO PRIOR ART

        A.   <u>CLAIMS 1-4, 7-11 AND 14 --- 35 U.S.C § 102(b)</u>

        Claims 1-4, 7-11 and 14 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by the EAST software (software produced by the Search and Information Resources Administration at the United States Patent and Trademark Office)(the "Software"), and the additional reference "U.S. Patents Text Search Quick Reference Guide for EAST (1.1)" (the "Guide"). The rejection is respectfully traversed.

As a preliminary, Applicants have no record of receipt of a copy of the Guide, and should the Examiner maintain this rejection, Applicants respectfully request a copy of the Guide. The Section 102(b) rejection is traversed on the two bases listed below.

(1) <u>The Section 102(b) Rejection is Defective as the Rejection Relies on a Set of the Unsupported Actions Manufactured by the Examiner</u>

Regarding current claim 1, this claim reads as follows:

A computer-implemented method of displaying a compound word, the method comprising:
receiving data that specifies a first form of a component word;
locating, within said compound word, a second form of said component word that differs from said first form of said component word; and
displaying said compound word with said second form of said component word visibly distinguished from the remainder of said compound word.

The Office action at pages 2-4 describes features of the Software and includes screenshots of the Software to establish a date prior to Applicants' filing date. However, the rejection of claim 1 depends on a hypothetical use of the Software manufactured by the Examiner that has <u>not</u> been shown either to be: (a) "described in a printed publication" prior to Applicants' filing date, or (b) "in public use or on sale" prior to Applicants' filing date. A proper rejection under 35 U.S.C. § 102(b) would require a positive showing of at least one of items (a)-(b), in addition to establishing the Software taught all claim limitations.

The rejection of Claim 1 reads as follows (emphasis added):

Referring to claim 1, East discloses receiving data that specifies a first form of a component word (input into BRS form, with the use of truncation, **for example**: fish$); locating, within said compound word (**for example**, the compound word is fisherman), a second form of said component word (**in this case**, fisher) that differs from said first form of said component word (**Once the browse button is pressed** the words that are constructed from the use of the truncation fish$ is highlighted); and displaying said compound word with said second form of said component word visibly distinguished from the

remainder of said compound word (**the use of the Find function**, such as, typing in fisher).

Thus the rejection of claim 1 appears to be based on a hypothetical example in which the Software is used to search for the truncated term "fish$", followed by viewing the results that highlight strings beginning with the text "fish" (and in this hypothetical, the results include the word "fisherman"), followed by manually using the "Find function" to locate and highlight the word "fisher" that so happens to be found within the word "fisherman".

However, the Office action cites <u>no</u> publication teaching use of the Software in this manner. Additionally, the Office action cites <u>no</u> date that the Software was actually used in this manner; further, the Office action even <u>fails to explain</u> why a user (e.g. a public searcher or an Examiner) would use the Software in this manner. Logically, if a user desired to view search results highlighting the word "fisher," the user would first perform an search using the string "fisher" or "fisher$" with the Software.

Therefore, the Office action fails to establish a proper case of anticipation.

(2) <u>The Section 102(b) Rejection Fails to Teach Every Element of Applicants' Claimed Method</u>

Even if the Section 102(b) rejection properly set forth one of items (a)-(b) described above, the rejection still fails to teach every element of Applicants' claimed method. In particular, the first step in the Office action's hypothetical (the first step being the input into BRS of the string "fish$") fails to meet Applicants' first step of current claim 1 of "receiving data that specifies a first form of a **component word.**"

Applicants respectfully submit that the string "fish$" cannot be considered a "component word" as claimed by Applicants, because a "component word" as used by Applicants in the Specification is a <u>real</u> word, and "fish$" is not a real word. At best, "fish$"

could be considered a truncated string, but nothing more. This distinction is crucial, as the Office action's complete hypothetical would fail had the Examiner first input "fish" into BRS instead of "fish$." Therefore, the Office action's hypothetical fails to teach or suggest "receiving data that specifies a first form of a component word" as appears in Applicants' current claim 1.

Finally, the Office action makes <u>no</u> assertion that the Software inherently performs Applicants' claimed method.

Regarding the rejection of current independent Claim 4, Applicants respectfully traverse the rejection using the arguments above made for current independent Claim 1.

For these reasons, Applicants respectfully request reconsideration and withdrawal of the anticipation rejections.

    B.   <u>CLAIMS 5-6 AND 12-13 --- 35 U.S.C § 103(a)</u>

Claims 5-6 and 12-13 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable by the Software, in view of U.S. Pat. Pub. 2003/0187886 ("Hull").

All Section 103(a) rejections are respectfully traversed. As previously shown, the anticipation rejection fails to establish either publication or public use prior to the critical date. No combination of the Software with one or more of Hull and the cited pertinent prior art cures the deficiencies of the anticipation rejection as described above.

As previously shown, the anticipation rejection additionally fails to teach or suggest "receiving data that specifies a first form of a component word." No combination of the Software with one or more of Hull and the cited pertinent prior art teaches or suggests this feature of Applicants' claimed method.

Therefore, Applicants respectfully request reconsideration and withdrawal of the obviousness rejections.

III.   CONCLUSION

The pending claims not discussed so far are dependent claims that depend on an independent claim that is discussed above. Because each of the dependent claims include the limitations of claims upon which they depend, the dependent claims are patentable for at least those reasons the claims upon which the dependent claims depend are patentable. Removal of the rejections with respect to the dependent claims and allowance of the dependent claims is respectfully requested. In addition, the dependent claims introduce additional limitations that independently render them patentable.

For example, in the method of Claim 2, a superlative form of a component word such as "best" is displayed within a compound word when the first form of the component word is "good." In new Claim 15, the computer-implemented method is performed by a search engine.

For the reasons set forth above, Applicants respectfully submit that all pending claims are patentable over the art of record, including the art cited but not applied. Accordingly, allowance of all claims is hereby respectfully solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If applicable, a law firm check for the petition for extension of time fee is enclosed herewith. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to charge any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Dated: March 12, 2008   _____/Samuel S. Broda #54802/_____
Samuel S. Broda
Reg. No. 54,802

2055 Gateway Place Suite 550
San Jose, California 95110-1093
Telephone No.: (408) 414-1080 ext 239
Facsimile No.: (408) 414-1076